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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,145	05/03/2006	Teruki Hayashida	52433/846	8822
26646 7590 09/29/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
FOGARTY, CAITLIN ANNE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
09/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,145

Applicant(s)

HAYASHIDA ET AL.

Examiner

CAITLIN FOGARTY

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 24, 2009 has been entered.

Status of Claims

2. Claim 1 is pending and has been amended. Claims 2 – 8 have been cancelled.

Status of Previous Rejections

3. The 35 U.S.C. 103(a) rejection of claims 1, 2, 7, and 8 as being unpatentable over Matsuoka et al. (US 2003/011144) has been withdrawn in view of the amended claims filed July 24, 2009.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2003-155541 from the IDS (hereinafter JP '541).

With respect to instant claim 1, [0011]-[0014] and [0051] of JP '541 disclose a hot rolled steel sheet excellent in chemical convertibility with an overlapping composition as seen in the table below.

Element	Instant Claim 1 (mass %)	JP '541 (mass %)	Overlapping Range (mass %)
C	0.03 – 0.15	0.03 – 0.10	0.03 – 0.10
Si	0.8 – 3.0	0.05 – 1.2	0.8 – 1.2
Mn	0.5 – 3.0	1.0 – 2.0	1.0 – 2.0
P	≤ 0.07	≤ 0.05	≤ 0.05
S	≤ 0.01	≤ 0.01	≤ 0.01
Al	0.015 – 0.1	0.01 – 0.05	0.015 – 0.05
N	0.001 – 0.008	≤ 0.005	0.001 – 0.005
Fe + Impurities	Balance	Balance	Balance

JP '541 also teaches that the steel sheet may comprise Ti, Nb, Ni, or Ca. However, the claim limitation recites "optionally" and therefore these elements are not required claim limitations of instant claim 1. Furthermore, [0012] and [0028] of JP '541 disclose that the steel *may* comprise Cu. Since Cu is an optional element in the steel of JP '541, the steel sheet of JP '541 may be free from containing Cu which satisfies the instant claim 1 limitation. In addition, JP '541 does not teach that Mo is present in the steel and therefore it is assumed that the steel sheet is also free from containing Mo.

In regards to instant claim 1, JP '541 also teaches in [0038]-[0041] that the steel sheet has a surface oxide film comprising Si. JP '541 does not specifically teach the mass% of Si or that the oxide film comprises a concentration of Mn. However, one of ordinary skill in the art would have expected the oxides on the steel sheet surface of JP '541 to have a Si and Mn concentration similar to the concentrations of the oxides on the instant steel sheet surface because the steel sheet of JP '541 has a similar

composition and is made using a method similar to that of the instant invention. See MPEP 2112.

JP '541 differs from instant claim 1 because it does not specifically teach that the hot rolled steel sheet is free from bald spots or the roughness and the number and size of pittings of the steel sheet. However, since the steel sheet of JP '541 has an overlapping composition and a process of making similar to that of the instant invention, one of ordinary skill in the art would have expected that the steel sheet of JP '541 would be free from bald spots and would have a similar roughness and number and size of pittings. See MPEP 2112.

The claim 1 limitation "the steel sheet obtained by pickling by dipping the steel sheet..." is a process limitation in a product-by-process claim and even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious for a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113. Therefore, in the absence of evidence to the contrary, the Examiner takes the position that the pickling step disclosed in [0032]-[0042] of JP '541 is similar to the pickling step recited in the instant invention and therefore the steel sheet of JP '541 would be expected to have structural properties as a result of the pickling similar to those of the instant invention. See MPEP 2112.

Since the claimed compositional ranges of claim 1 either overlap or are within the ranges disclosed by JP '541, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed steel alloy composition from the steel alloy composition disclosed by JP '541 because JP '541 teaches the same utility (i.e. automobile parts) in the whole disclosed range.

Response to Arguments

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

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